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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,579	06/23/2003	Joseph Sery	81571	9643
7590	10/19/2004		EXAMINER	
JOSEPH SERY TUNGSTEN HEAVY POWDER INC. 9090 KENAMAR DR. SAN DIEGO, CA 92121			BELLINGER, JASON R	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/600,579	SERY, JOSEPH
	<b>Examiner</b>	<b>Art Unit</b>
	Jason R Bellinger	3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 26 July 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1 and 3-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 11-20 is/are allowed.

6)  Claim(s) 1 and 3-8 is/are rejected.

7)  Claim(s) 9 and 10 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

***Allowable Subject Matter***

1. The indicated allowability of claims 2-5 is withdrawn in view of the newly discovered reference(s) to Green et al. Rejections based on the newly cited reference(s) follow.

***Drawings***

2. The drawings were received on 26 July 2004. These drawings are approved.

***Claim Objections***

3. Claims 1 and 9 are objected to because of the following informalities: A comma (,) should be inserted after the term "properties" in lines 6 of claim 1. The term "an" following the term "having" should be removed from line 2 of claim 9 for grammatical clarity.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
5. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 is indefinite due to the fact that it is unclear whether

the "hollow body" is the small element as the body having a cavity (or cavity-containing body) as set forth in claim 1, or a separate element of the invention altogether.

6. Claim 5 recites the limitation "the hollow body" in line 3. There is insufficient antecedent basis for this limitation in the claim. The limitation of a "hollow body" has not been previously set forth in claim 5, nor in claim 1, from which claim 5 depends.

#### ***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of Kogure et al. Green et al shows a balance weight assembly having a body 12 including a metal clip portion 24, which provides a hook portion having a cross-sectional shape that corresponds to a flanged edge portion L of a wheel rim, and a cavity 32 for holding a separate high-density weight 48. The weight 48 is secured in the cavity 32 by a fill material 72 having adhesive properties. The metal clip 24 is partially embedded within the body 12.

Green et al does not show the body being formed from a polymeric material. Kogure et al teaches the use of a body 6 formed from a polymeric material (see column 3, lines 27-31). Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the body of Green et al from a

polymeric material for the purpose of creating a balance weight assembly using materials other than lead to reduce health risks.

Green et al as modified by Kogure et al does not specify that the body 12 is made by injection molding where the body 12 is molded about the metallic clip 24. Injection molding is a well-known method of forming objects from a polymeric material. It is further well known in the art to injection mold a polymeric material around an insert. Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to form the body of Green et al as modified by Kogure by injection molding to reduce manufacturing costs.

The metallic clip 24 has a straight body section that is located closer to the inner wall of the body 12 that defines the cavity 32 than the surface that defines an outer face 16 of the body 12.

Green et al does not specify that the high-density weight is formed of a solid body of tungsten or a tungsten-polymer combination. Kogure et al teaches the use of a weight 6 formed as a solid body of tungsten or a tungsten-polymer combination (see column 3, lines 27-31). Kogure et al does not specify that the high-density weight is formed of a body of tungsten powder having an apparent density of not less than 10 g/cc compounded with a polymeric binder. However, one of ordinary skill in the art at the time of the invention would have found it obvious to provide an amount of tungsten powder having an apparent density suitable for producing a balance weight with sufficient mass to properly balance a wheel.

Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the weight of Green et al out of a solid body of tungsten or a tungsten-polymer combination as an equivalent substitution for lead, without the serious health issues of lead.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al in view of Kogure et al as applied to claims 1, 3-7 above, and further in view of Bajer. Kogure et al does not show the balance weight being formed as a rod. Bajer teaches the use of a balance weight that is formed as a rod (see Figure 2). From this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the balance weight of Kogure et al as a rod for the purpose of creating a visibly appealing weight and to decrease the amount of storage space required to store the weights.

#### ***Allowable Subject Matter***

10. Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 11-20 have been found to be allowable over the prior art.

***Response to Arguments***

12. Applicant's arguments with respect to claims 1, and 3-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered to show balance weight assemblies having a body in which a weight is mounted. For example, Lyon ('142) shows a weight assembly of the type described above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R Bellinger whose telephone number is 703-308-6298. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



S. JOSEPH MORANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Art Unit: 3617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger  
Examiner  
Art Unit 3617

  
rb